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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,184	10/16/2003	Tatsuya Ishizuka	14867A	7582
23389	7590	11/17/2006		
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER LEUBECKER, JOHN P	
			ART UNIT 3739	PAPER NUMBER

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/687,184	<b>Applicant(s)</b> ISHIZUKA, TATSUYA	
	<b>Examiner</b> John P. Leubecker	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-6 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-6 and 16-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/931,847.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 5, 2006 has been entered.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4-6, 16, 18 and 20-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Higuma et al. (U.S. Pat. 6,547,721).

Referring mainly to Figure 22, Higuma et al. disclose a push-button switch (13) including a switch (148) capable of being autoclaved, and a pressing member (150,149) that shields the switch to keep it watertight (col.25, lines 34-36), includes a presser (149), can at least partly deform, and can be displaced in a direction in which the switch is pressed. A predetermined distance exists between the presser (149) and the switch (148). Inherently, depending on the

predetermined distance, there is a preset force which is required to press the switch—any force less than that will not press the switch. Since no particular pressure is claimed and the pressure in any particular autoclave device can vary from zero to what is disclosed by Applicant, the predetermined distance will meet the claim limitations up to the pressure that causes the force required to press the switch. Claims 4 and 5 adds nothing structurally to the claim but proposes from where a force is intended to come. As to claim 6, note linking means (20) in Figure 2. As to claim 16, note waterproof film (150). As to claim 18, it is inherently the materials and shape (which dictates “hardness”) of the pressing member which gives it the properties as mentioned above. As to claims 20, 23 and 24, the steps of providing the structure as mentioned above are anticipated by the structure mentioned above. The gap (predetermined distance) mentioned above will inherently be maintained by at least some of the pressures due to autoclaving. As to claim 21, the distance is inherently set to a value that disables contact between the presser and switch since the decompression step is essentially a vacuum (e.g., negative pressure with respect to atmosphere). As to claim 22, the difference between a decompression step (negative pressure) and pressurization step (positive pressure) includes zero (no pressure) which will not enable the presser to contact the switch.

4. Claims 1, 4, 5, 16-18, 20-22, 24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Donofrio et al. (U.S. Pat. 6,608,270).

Donofrio et al. disclose a push-button switch (Fig.2) including a switch (details best seen in Figure 11), a pressing member (82, Fig.2), a presser (87, Fig.4) and a predetermined distance between the presser and switch (seen in Figure 2 but best shown in Figure 11). Inherently,

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depending on the predetermined distance, there is a preset force which is required to press the switch—any force less than that will not press the switch. Since no particular pressure is claimed and the pressure in any particular autoclave device can vary from zero to what is disclosed by Applicant, the predetermined distance will meet the claim limitations up to the pressure that causes the force required to press the switch. Pressing member comprises a waterproof film (col.5, lines 1-3) and can include a coil spring (col.8, lines 61-64). As to claims 18 and 20-25, note structure cited above and discussion of these claims above with respect to Higuma et al. Furthermore, note column 7, lines 43-56 concerning the reduction of “adverse effects” which are discussed in column 2, lines 27-50.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, 5, 16-18, 20-22, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. Pat. 5,658,238) in view of Taylor (U.S. Pat. 4,021,630).

Referring mainly to Figure 9, Suzuki et al. disclose a push-button switch including a switch (45a,45b), a pressing member (33a), a presser (45c), a space between the presser and switch (Fig.9), and a spring (43). A predetermined distance exists between the presser and the switch. Inherently, depending on the predetermined distance, there is a preset force which is

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required to press the switch—any force less than that will not press the switch. Since no particular pressure is claimed and the pressure in any particular autoclave device can vary from zero to what is disclosed by Applicant, the predetermined distance will meet the claim limitations up to the pressure that causes the force required to press the switch. Suzuki et al. fails to disclose that the pressing member keeps the switch watertight or is waterproof in itself. If not inherent from its intended use (medical procedures often fluids, either from the body or from equipment), it would have been obvious to one of ordinary skill in the art to have made the switch watertight, using waterproof materials, to protect the internal switch components from corrosion and contamination. Watertight or waterproof switches are known in the surgical art as evidenced by the multiple references cited in this Office Action, and the level of ordinary skill would necessitate knowledge of this concept due to the nature of medical procedures. Taylor evidences that such concept is old and well known (col.1, lines 24-32). As to claim 18, it is inherently the materials and shape (which dictates “hardness”) of the pressing member which give it the properties as mentioned above. As to claims 20, 24 and 25, the steps of providing the structure as mentioned above are anticipated by the structure mentioned above. The gap (predetermined distance) mentioned above will inherently be maintained by at least some of the pressures due to autoclaving. As to claim 21, the distance is inherently set to a value that disable contact between the presser and switch since the decompression step is essentially a vacuum (e.g., negative pressure with respect to atmosphere). As to claim 22, the difference between a decompression step (negative pressure) and pressurization step (positive pressure) includes zero (no pressure) which will not enable the presser to contact the switch.

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7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Higuma et al. and separately over Donofrio et al. in view of Higuma et al.

Since both Higuma et al. and Donofrio et al. each disclose devices that are capable of being autoclaved, it is only logical and thus obvious that these devices are specifically designed to withstand the autoclaving process. This would include making the devices out of suitable materials and designing the device in a way in which the device does not leak, deform, malfunction or deteriorate. Since a switch which deforms under the known autoclave pressure would conceivably cause damage or malfunction of such switch, it would be obvious to one of ordinary skill in the art, and logical when specifically designing a device to withstand the autoclave process, to design the entire device, including parts susceptible to pressure, to withstand all of pressure, temperature and chemical reaction associated with the autoclave process. Higuma et al. disclose that a pressure of one known autoclave process is "the atmospheric pressure +0.2 MPa or so" (col.1, line 67 to col.2, line 2). Therefore it would be obvious for the reasons above to design the devices of Higuma et al. and Donofrio et al., including the switches, to withstand a pressure of +0.2 MPa above atmospheric pressure. This would inherently include +0.3 MPa.

### ***Response to Arguments***

8. Applicant's arguments filed September 5, 2006 have been fully considered but they are not persuasive.

Applicant argues that the claimed device is suitable for autoclaving. The Examiner wishes to point out that both Higuma et al. and Donofrio et al. also disclose devices suitable for

autoclaving. A device in which the switch malfunctions due to autoclave pressures would not be suitable for autoclaving. However, the Examiner addresses the claim amendments and new claims nonetheless.

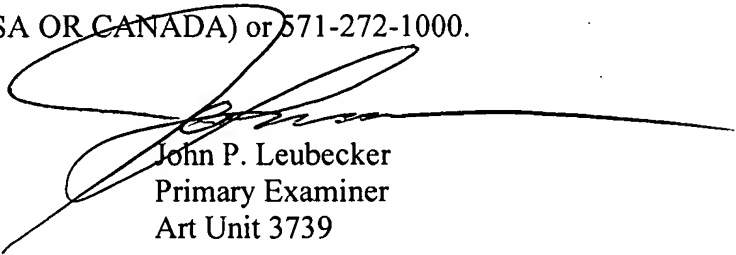
Regarding Applicant's request to withdraw Donofrio et al. as a reference, it is noted that Applicants effective filing date is August 17, 2001. Thus, Donofrio et al. will not be withdrawn as a reference.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John P. Leubecker  
Primary Examiner  
Art Unit 3739